

Appl. No. 10/010,068
Amdt. dated January 26, 2005
Reply to Office Action of October 26, 2004

PATENT

REMARKS/ARGUMENTS

Amendments

The claims are modified in the amendment. More specifically, claims 1, 6-10, 14-16, 18, 23 and 25-28 have been amended; claim 29 has been cancelled; and new claim 30 has been added. Therefore, claims 1-28 and 30 are present for examination. No new matter is added by these amendments. Applicant respectfully requests reconsideration of this application as amended.

Incomplete Office Action

The Office Action indicates that claims 1-22 are rejected, but does not address claims 23-29 that were part of the application at the time the Office Action was issued. A preliminary amendment was properly filed on January 24, 2003, but is not addressed by the Office Action. A check of private PAIR on January 25, 2005 confirms in the imaged file wrapper that the preliminary amendment was received by the Office. A non-final Office Action that addresses all claims is respectfully requested.

35 U.S.C. §102 Rejection, Small

The Office Action has rejected claims 1, 2, 4-11 and 13-22 under 35 U.S.C. §102(b) as being anticipated by the cited portions of U.S. Patent No. 5,513,117 to Small (hereinafter "Small"). For a valid anticipation rejection, the Office must show that each and every limitation from the claims appears in a single piece of prior art. Applicants believe major limitations from amended claims 1, 10 and 18 are neither taught nor suggested in the Small reference. More specifically, Small cannot be relied on to teach or suggest: (1) a stored value fund that includes a monetary credit as the electronic gift as generally required by claims 10 and 18, (2) a monetary credit in a stored value fund can be used by the receiver with any money handler of the receiver's choosing as required by claim 18, or (3) having an electronic greeting card with a code that indicates a link to a site associated with redemption of an electronic gift as

Appl. No. 10/010,068
Amdt. dated January 26, 2005
Reply to Office Action of October 26, 2004

PATENT

generally required by claims 1, 10 and 18. Applicants respectfully request that the anticipation rejection be withdrawn for these reasons.

First Missing Limitation: Credit In Stored Value Fund Is Gift

Small discusses various options for gifts, but does not contemplate a stored value fund as generally required by claims 10 and 18. Small, col. 1, lines 20-26; col. 3, lines 39-51. A stored value fund can act as a online clearinghouse for funds that offers great flexibility to the recipient. The ways the monetary credit can be used are a huge improvement over Small. Small only allows a limited number of gift types, but use of a stored value fund provides the recipient a large amount of flexibility that no mere gift certificate or phone card can.

Second Missing Limitation: Recipient Choice of Money Handler

Small only describes the scenario where a physical or electronic gift is included with the card. Claim 18 provides the recipient the choice of any money handler to use. The recipient can remove the monetary credit from the stored value fund with the money handler of his/her choosing. In one embodiment, this allows the recipient to choose from a prepaid debit card, a gift certificate, an agent location, etc.. Small has no such flexibility as the recipient is locked into whatever type of electronic gift was chosen by the sender.

Third Missing Limitation: Link to Redemption Site in Electronic Card

Small does not include links in the electronic card as generally required by all claims. The Office Action cites Fig. 6, reference designator 83, for this proposition, but that figure depicts the card order screen. Having a link the electronic card allows the recipient to quickly pull-up the page of the redemption site and start using the gift.

In light of these differences, reconsideration of the claims is respectfully requested.

35 U.S.C. §103 Rejection, Small in view of Business Wire

The Office Action has rejected claims 3 and 12 under 35 U.S.C. §103(a) as being unpatentable over Small in view of the cited portions of Non-Patent Literature Document Item: W "Business Wire" (hereinafter "BW"). Beyond the arguments provided with regard to Small in

Appl. No. 10/010,068

Amdt. dated January 26, 2005

Reply to Office Action of October 26, 2004

PATENT

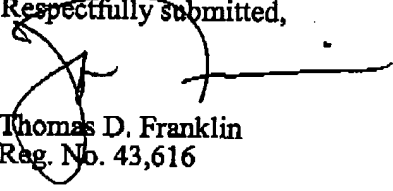
the preceding section, Applicant only notes in passing that no cite is given for the motivation to combine Small and BW. Office Action, page 4, last sentence. Because there is no cite, it is unclear to the Applicant where the motivation to combine comes from. The Office is respectfully requested to clarify if Official Notice is the source of this motivation. Should the rejection be maintained and Official Notice is relied upon, an express showing of proof is respectfully requested as set forth in MPEP 2144.03.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,


Thomas D. Franklin
Reg. No. 43,616

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 303-571-4000
Fax: 415-576-0300
TDF:cmb

80349038 v1